

| PRE-APPEAL BRIEF REQUEST FOR REVIEW   |  | Docket Number (Optional) |                |
|---|--|--------------------------|----------------|
| I hereby certify that this correspondence is being e-filed with the USPTO<br><br>on <u>September 26, 2007</u><br><br>Signature <u>/Dana Chan/</u><br><br>Typed or printed name <u>Dana Chan</u>           |  | Application Number       | Filed          |
|   |  | 09/879,683               | 06/11/2001     |
|   |  | First Named Inventor     |                |
|   |  | Limor Schweitzer         |                |
|   |  | Art Unit                 | Examiner       |
|   |  | 3692                     | Milef, Elda G. |
| Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.  |  |                          |                |
| This request is being filed with a notice of appeal.  |  |                          |                |
| The review is requested for the reason(s) stated on the attached sheet(s).<br>Note: No more than five (5) pages may be provided.  |  |                          |                |
| I am the  |  | /KEVINZILKA/             |                |
| <input type="checkbox"/> applicant/inventor.  |  | Signature                |                |
| <input type="checkbox"/> assignee of record of the entire interest.<br>See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.<br>(Form PTO/SB/96)   |  | Kevin J. Zilka           |                |
| <input checked="" type="checkbox"/> attorney or agent of record.      41,429  |  | Typed or printed name    |                |
| Registration number _____   |  | 408-971-2573             |                |
| <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.  |  | Telephone number         |                |
| Registration number if acting under 37 CFR 1.34 _____   |  | September 26, 2007       |                |
|   |  | Date                     |                |
| NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.<br>Submit multiple forms if more than one signature is required, see below*. |  |                          |                |
| <input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.   |  |                          |                |

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## REMARKS

The Examiner has rejected Claims 1, 3, 8-12, 27, 28, and 30 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, with respect to Claim 1, the Examiner has stated that there is insufficient antecedent basis for the limitation “the information” in line 9. Applicant respectfully disagrees and asserts that, clearly, “the information” refers to the limitation of “receiving information utilizing a network, wherein the information includes...” (emphasis added).

Furthermore, also with respect to Claim 1, the Examiner has argued that the meaning of the limitation “wherein the site sends the information” is unclear and has questioned “[w]here...the information [is] being sent.” Applicant respectfully disagrees and asserts that Claim 1 is not limited to a specific location to which the information is sent.

The Examiner has rejected Claims 1, 8-11, 13, 20-23, 25-28, and 30 under 35 U.S.C. 103(a) as being unpatentable over Ronen (U.S. Patent No. 5,905,736), in view of Egendorf (U.S. Patent No. 5,794,221), and in further view of Foster (U.S. Patent No. 6,332,134). Applicant respectfully disagrees with such rejection.

With respect to independent Claims 1, 13, and 25, the Examiner has relied on Col. 5, lines 52-67 and Cols. 2, 5, and 6 from the Ronen reference, in addition to Col. 4, lines 1-6 from the Egendorf reference to make a prior art showing of applicant’s claimed technique “wherein user data is identified based on the received information, and the user data is sent to a site, wherein the user data includes shipping information” (see this or similar, but not necessarily identical language in the aforementioned independent claims).

Applicant respectfully asserts that the excerpts from Ronen relied upon by the Examiner merely teach that “[b]efore completing the transaction, therefore, the accessed ISP, such as ISP 106, communicates with the transaction server 109 to determine whether

that IP address has an established billing entry to which charges for the transaction can be forwarded and recorded,” and that “[i]f such an entry exists on database 110 and a billing mechanism is in place, ISP 106 is signaled over the secured link, to authorize the transaction” (Ronen, Col. 5, lines 52-66 - emphasis added). Furthermore, the excerpt from Egendorf relied on by the Examiner simply teaches that “the vendor may verify with the provider that the address supplied by the customer for shipment of the goods has been authorized by the customer” (Egendorf, Col. 4, lines 1-3 - emphasis added).

Clearly, the excerpts from Ronen relied on by the Examiner merely disclose “determin[ing] whether [an] IP address has an established billing entry,” which does not even suggest any sort of “shipping information,” as applicant claims. Further, the excerpt from Egendorf relied on by the Examiner only discloses that “the address [is] supplied by the customer for shipment,” which does not suggest, and even *teaches* away from applicant’s claimed technique “wherein user data is identified based on the received information... wherein the user data includes shipping information,” particularly since such received information “includes an Internet Protocol (IP) address of a user and an amount of payment due” (emphasis added), in the context claimed by applicant.

In addition, although Egendorf discloses that “the vendor may verify with the provider that the address... has been authorized by the customer,” Egendorf only discloses that such verification may be performed “in the same manner in which such verification would be made for the same transaction made over the telephone with a credit card.” Thus, Egendorf simply does not meet applicant’s specific claim language, namely that “user data is identified based on the received information... wherein the user data includes shipping information” and where such received information “includes an Internet Protocol (IP) address of a user and an amount of payment due” (emphasis added), in the context claimed by applicant.

Applicant further notes that the Examiner has argued that “Ronen discloses the purchasing of goods that will later be delivered by conventional transport means,” such that “[i]t is obvious that in order for goods ordered online to be shipped to a consumer,

the consumer must provide shipping information.” Applicant again emphasizes that merely suggesting that Ronen teaches that a “consumer must provide shipping information,” as alleged by the Examiner, fails to rise to the level of specificity of applicant’s claim language, and even *teaches away* from such claim language. Applicant emphasizes that only applicant teaches and claims a technique where “user data [that includes shipping information] is identified based on received information,” where such received information “includes an Internet Protocol (IP) address of a user and an amount of payment due” (emphasis added), in the context claimed by applicant.

Based on the Examiner’s above noted argument, it appears that the Examiner has relied on an inherency argument regarding the above emphasized claim limitations. In view of the arguments made hereinabove, any such inherency argument has been adequately rebutted, and a notice of allowance or a specific prior art showing of such claim features, in combination with the remaining claim elements is respectfully requested (See MPEP 2112).

Further, in response, applicant asserts that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Additionally, with respect to the independent claims, the Examiner has relied on Col. 8, lines 42-63 and Cols. 7-8 from Foster to make a prior art showing of applicant’s claimed technique where “the site is provided with a confirmation number and the

shipping information of the user and the user is provided with the confirmation number” (see this or similar, but not necessarily identical language in the independent claims).

Applicant respectfully asserts that the excerpts from Foster relied upon by the Examiner merely teach that “[t]he message to the cardholder, shown at path 216 may be an order confirmation number or other indication that the order is to be placed,” and that “[t]he message to the merchant includes a unique order number and a pre-registered shipping address or an authorized alternate shipping address, as shown at path 218” (Col. 8, lines 45-50 - emphasis added). However, disclosing an order confirmation number sent to the cardholder and a unique order number sent to the merchant, as in Foster, fails specifically meet applicant’s claimed technique where “the site is provided with a confirmation number ... and the user is provided with the confirmation number” (emphasis added), as claimed by applicant.

With respect to independent Claim 26, the Examiner has relied on Cols. 1 and 2 from Ronen to make a prior art showing of applicant’s claimed “providing a link to a site on a network where a business transaction is occurring.”

Applicant respectfully asserts that the excerpt from Ronen relied on by the Examiner only generally discloses “transaction[s] conducted over the Internet by users connected through an Internet Access Provider (IAP) to one or more ISPs” (Col. 2, lines 5-8). However, applicant respectfully notes that nowhere in the excerpt relied on by the Examiner is there any specific disclosure of “providing a link to a site on a network where a business transaction is occurring” (emphasis added), as applicant claims.

Also with respect to independent Claim 26, the Examiner has relied on the rejection of Claim 8, and in particular Col. 7, lines 37-40 and item 120-3 in Figure 1 of Ronen, to make a prior art showing of applicant’s claimed “conditionally administering payment for the payment due by billing against the account in accordance with any identified rules.”

Applicant respectfully asserts that item 120-3 in Figure 1 of Ronen merely shows a bank debit card. Further, Col. 7, lines 37-40 from Ronen simply discloses that the “billing mechanism will include the user’s desired method or methods of billing, and any parameters that define when a particular billing method is to be applied.” Clearly, parameters that define when a particular billing method is to be applied, as in Ronen, fails to meet applicant’s claimed “conditionally administering payment...in accordance with any identified rules” (emphasis added), as claimed. In fact, applicant notes Table 1 in Ronen (shown in Col. 4, lines 50-60), which clearly shows parameters for each billing choice, which does not teach that “payment [is conditionally administered]... in accordance with any identified rules” (emphasis added), as claimed.

Still with respect to independent Claim 26, the Examiner has relied on Col. 4, lines 1-6 in Egendorf to make a prior art showing of applicant’s claimed “identifying shipping information based on the received information.”

As argued above with respect to the remaining independent claims, applicant respectfully emphasizes that the excerpt from Egendorf relied on by the Examiner simply discloses that “the vendor may verify with the provider that the address supplied by the customer for shipment of the goods has been authorized by the customer.” Clearly, simply verifying an address supplied by a customer, as in Egendorf, fails to specifically teach, and even *teaches away* from, applicant’s claimed “identifying shipping information based on the received information,” especially where such received “information includes an Internet Protocol (IP) address of [the] user and an amount of payment due” (emphasis added), in the context claimed.

In addition, although Egendorf discloses that “the vendor may verify with the provider that the address... has been authorized by the customer,” Egendorf only discloses that such verification may be performed “in the same manner in which such verification would be made for the same transaction made over the telephone with a credit card.” Thus, Egendorf simply does not meet applicant’s specific claim language.